

under 35 USC §103(a) as being unpatentable over Caldwell in view of Linscott in view of Silverberg in view of Ando in view of Dahlgren. New claims 198-215 have been added.

35 USC §102(b):

Claims 1, 133-140, 143, 144, 146-154, 160-165, 179-183, 185 and 188-197 stand rejected under 35 USC §102(b) being anticipated by Caldwell. In the previous Office Actions, the Examiner stated that the “limitations drawn to the polymer and the porous web are work piece limitations...” that are “...not germane to the patentability of the apparatus itself.” During the telephonic interview on October 24, 2000, Examiner referenced section 2114 of the Manual of Patent Examining Procedure, noting that “**apparatus** claims cover what a device is, not what a device does.” The Examiner added that by claiming the present invention as a “**system**”, the claims, as a whole would be considered, including the “work piece limitations” that are “...not germane to the patentability of the **apparatus** itself”. Accordingly, Applicant has amended claims 1, 133 and 188 to recite a “**system**” rather than “**apparatus**”.

Regarding claim 1, the Caldwell reference fails to disclose a “means for shear thinning the polymer composition...” as recited in line 7. The first Office Action admitted that Caldwell fails to disclose “shear thinning”. However, the Examiner has not previously given weight to “work piece limitations” drawn to the polymer and the porous web. As noted above, pursuant to the telephonic interview of October 24, 2000, Applicant has amended claim 1 to recite a “system” rather than an “apparatus” and respectfully requests the Examiner to consider these limitations.

Moreover, “all words in a claim must be considered in judging the patentability of the claims against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970). Claim 1 recites an “Apparatus for controlling the placement of a polymer composition into a porous web...”. Applicant admits that both the polymer and porous web are claimed in a functional manner. However, the mere fact that these limitations are functional does not mean they are to be given no weight. To the contrary, the MPEP states that “A functional limitation must be evaluated and considered just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used” (MPEP 2173.05(g)).

Further regarding claim 1, Caldwell fails to disclose or suggest encapsulation of at least some of the structural elements of the web. "Encapsulation" refers to "the partial or complete surrounding, encasement or enclosing by a discrete layer, film, coating, or the like, of exposed surface portions of at least some individual fiber or lining of a cell or pore wall of a porous web" (page 17, lines 28-30). Claim 1 calls for a 'means for shear thinning...*to encapsulate at least some of the structural elements of the porous web by enveloping exposed surface portions of the structural elements*'. The Caldwell reference simply does not teach encapsulation, particularly as presently claimed. Thus, claim 1 is now believed to be allowable over the prior art. Accordingly, claims 134-143, 145-186 and 193-196, which depend from claim 1, are also believed to be allowable.

Regarding claim 133, the Caldwell reference fails to disclose or suggest a "means for controlling said tension applying means and said blade means to shear thin the polymer composition to substantially reduce its viscosity and to selectively place it into the tensioned web to encapsulate at least some of the structural elements of the porous web *by enveloping exposed surface portions of the structural elements*." The Examiner has failed to set forth a *prima facie* rejection of claim 133 because Caldwell does not teach or suggest shear thinning or encapsulation, particularly as presently claimed. Thus, claim 133 is now believed to be allowable over the prior art. Accordingly, claims 144, 187, 191, 192 and 197, which depend from claim 133, are also believed to be allowable.

Regarding claim 188, the Caldwell reference fails to disclose or suggest a "means for shear thinning the polymer composition to reduce its viscosity and place it to encapsulate at least some of the structural elements of the porous web *by enveloping exposed surface portions of the structural elements*." The Examiner has failed to set forth a *prima facie* rejection of claim 188 because Caldwell does not teach or suggest shear thinning or encapsulation, particularly as presently claimed. Thus, claim 188 is now believed to be allowable over the prior art. Accordingly, claims 189 and 190, which depend from claim 188, are also believed to be allowable.

### 35 USC §103(a): Caldwell in view of Marzocchi:

Claims 166-172 stand rejected under 35 USC §103(a) as being unpatentable over Caldwell in view of Marzocchi. Applicants respectfully request allowance of claims 166-172 for the reasons set forth regarding claim 1.

35 USC §103(a): Caldwell and Linscott:

Claims 142, 145, 155-159 and 187 stand rejected under 35 USC §103(a) as being unpatentable over Caldwell in view of Linscott. Applicants respectfully request allowance of claims 142, 145, 155-159 and 187 for the reasons set forth regarding claim 1.

35 USC §103(a): Caldwell, Linscott and Marteness:

Claims 175-178 stand rejected under 35 USC §103(a) as being unpatentable over Caldwell in view of Linscott and further in view of Marteness. Applicants respectfully request allowance of claims 175-178 for the reasons set forth regarding claim 1.

35 USC §103(a): Caldwell and Linscott in view of Silverberg in view of Ando in view of Dahlgren:

Claims 141, 166, 173, 174, 184 and 186 stand rejected under 35 USC §103(a) as being unpatentable over Caldwell in view of Linscott in view of Silverberg in view of Ando in view of Dahlgren. Applicants respectfully request allowance of claims 141, 166, 173, 174, 184 and 186 for the reasons set forth regarding claim 1.

New Claims 198-215:


Regarding claims 198-215, Applicant maintains that these claims are patentable because they depend from allowable claims 1, 133 or 188, and because they set forth new limitations not found in the prior art.

***Conclusion***

On the basis of the above amendment and remarks, reconsideration and allowance of the application is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments regarding this communication, he is respectfully urged to contact the undersigned at the number listed below.

Respectfully submitted,  
LYON & LYON LLP

Dated: October 25, 2000

By:   
David Heisey  
Reg. No. 42,651

633 West Fifth Street, 47th Floor  
Los Angeles, CA 90071-2066  
Phone: (858) 552-8400  
Fax: (213) 955-0440

RECEIVED  
NOV - 3 2000  
TC 1700 MAIL ROOM